

REMARKS

Claims 1-48 are currently pending in the subject application and are presently under consideration. Claims 1-2, 4-11, 13-20, 22, 25, 29-39, 41-42, 44-48 have been amended as shown on pp. 9-19 of the Reply. The specification has been amended as indicated on pp. 2-7 of the Reply. The drawings have been amended as indicated on p. 8 of the Reply, and a new set of formal drawings are submitted. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to Drawings

The Examiner has objected to Figure 2 because “the use of “>1” for expressing “more than one” is confusing.” (Office Action at p. 2). A proposed drawing is provided with the correction noted in red. Figure 10 is objected to as being identical to Figure 9. (See Office Action at p. 2). Figure 10 has been deleted and accordingly, Figures 11 and 12 have been renumbered. Applicant’s representative has submitted herewith a new set of formal drawings (incorporating the noted changes). Accordingly, withdrawal of these objections is respectfully requested

II. Objection to use of trademark VISUAL BASIC

The specification has been amended and all instances of the term “Visual Basic” are now capitalized. Applicant’s representative notes that the trademark “Visual Basic” is owned by Microsoft Corporation and that Microsoft Corporation is the assignee of the subject patent application.

III. Objection to Claims 3-7, 9-10, 14-15, 18-19, 30-33, 36-38, 41-43 and 45

Claims 3-7, 9-10, 14-15, 18-19, 30-33, 36-38, 41-43 and 45 stand objected to because the Examiner has indicated that it is improper punctuation to place a comma after the penultimate item in a series. (See Office Action at p. 4). Applicant’s representative respectfully disagrees. It is not only permissible to place a common after the penultimate item in a series, it is preferable. (See William Strunk, Jr. and E.B. White, *The Elements of Style*, p. 2 (3rd ed.1979), “[i]n a series

of three or more terms with a single conjunction, use a comma after each term except the last”; *see also* Strunk and White, *The Elements of Style*, (4th ed. 1999), available online at <http://www.bartleby.com/141/strunk.html#2>; *see also* Webster’s New Collegiate Dictionary, p. 1515, G&C Merriam Co., Springfield, MA (1981)). Hence the objection should be withdrawn.

IV. Objection to Claim 7 Under 37 CFR 1.75(c)

Claim 7 stands objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. (*See* Office Action at p. 4). Claim 7 has been amended herein, and withdrawal of this objection is requested.

V. Objection to Claims 29-31

Claims 29-31 stand objected to because of a typographical error. (*See* Office Action at p. 5). Withdrawal of this objection is requested in view of the amendments to these claims.

VI. Rejection of Claims 5-6, 8-11, 32 and 33 Under 35 U.S.C §112, First Paragraph

Claims 5-6, 8-11, 32 and 33 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the enablement requirement. (*See* Office Action at p. 5). Claims 5 and 32 have been amended and no longer include the limitation “explicit association.” Claims 6, 8-11 and 33 depend from claims 5 and 32, and accordingly no longer contain this limitation, either. Applicant’s representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The subject specification sufficiently enables one skilled in the art to make and use the invention as recited in the subject claims without undue experimentation.

VII. Rejection of Claims 1-2, 4-8, 10-11, 13, 16-20, 22, 25, 29-39 and 45-48 Under 35**U.S.C §112, Second Paragraph**

Claims 1-2, 4-8, 10-11, 13, 16-20, 22, 25, 29-39 and 45-48 stand rejected under 35 U.S.C. §112, second paragraph, as reciting terms that lack antecedent basis. (See Office Action at pp. 6-10). Claims 1-2, 4-8, 10-11, 13, 16-20, 22, 25, 29-39, and 45-48 have been amended. Applicant's representative notes that the limitation "a code body" recited in claim 18 appears for the first time in claim 18 and therefore, this limitation is proper as written. Accordingly, withdrawal of this rejection is respectfully requested.

VIII. Rejection of Claims 41-47 Under 35 U.S.C §112, Second Paragraph

Claims 41-47 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (See Office Action at page 9). Applicant's representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The claims are definite, as required by the second paragraph of 35 U.S.C. § 112, because one of skill in the art can readily determine the scope of the claims. The Examiner has made no showing that one of skill in the art would have any difficulty determining the scope of the claims.

The Office Action contends that claims 41-47 are indefinite because:

the term 'adapted to' is unclear. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. (Office Action at p. 9).

The Office Action cites to *In re Hutchinson* 154 F.2d 135, 69 U.S.P.Q. 138 (CCPA 1946) in support of the rejection. Applicant's representative respectfully submits that the holding of *Hutchinson* is not applicable to the subject claims. First, the court's ruling in *Hutchinson* was not a ruling on definiteness under 35 U.S.C. §112, second paragraph, but rather a ruling on claim scope to determine patentability in light of the prior art. Second, in *Hutchinson*, the claim at issue contained the term "adapted for" in the *preamble* merely as an expression of intended use

of the invention. (*Hutchinson*, 154 F.2d at 137, quoting exemplary claim 42 “an article of manufacture **adapted for** use in the fabrication of a metal template or the like suitable for metal-working operations”) (emphasis added). The applicant in *Hutchinson* argued that this language in the **preamble** distinguished the claims over the prior art. (*See Id.* at 138). The court held that the language relating to intended use in the preamble did not distinguish the claims because it was nonlimiting and that even if it were limiting, the prior art was adapted for the same use. (*See Id.*). Thus, the court’s holding in *Hutchinson* merely stood for the well-established rule that the **preamble** is not limiting “where it merely recites a ‘purpose or intended use of the invention.’ “ (*See Innova/Pure Water, Inc., v. Safari Water Filtration Systems, Inc.*, _ F.3d _ (Fed. Cir., Aug. 11, 2004, No. 04-1097) citing to *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994)). Unlike the claims at issue in *Hutchinson* (which contain the term “adapted for” in the preamble), the subject claims contain the phrase “adapted to” as a functional claim limitation in the **body** of the claim. Therefore, *Hutchinson* is not applicable to whether the subject claims are sufficiently definite under 35 U.S.C. §112 ¶2 because the ruling in that case was not in regards to definiteness and because the ruling is limited to claims like those at issue in the *Hutchinson* case - claims that contain statements of intended use in the **preamble**.

Moreover, the *Hutchinson* case was decided in 1946, prior to the enactment of 35 U.S.C. §112. (*See* 35 U.S.C.S. §112 (2004) (indicating the statute was initially enacted July 19, 1952)). In more recent cases interpreting 35 U.S.C. §112 ¶2, the predecessor court to the Federal Circuit has found patentable claims with the term “adapted” in both the body of the claim and the preamble. (*See In re Venezia*, 530 F.2d 956, 958-59 (CCPA 1976) (overturning the PTO Board of Appeals rejection under 35 U.S.C. §112 ¶2 and finding patentable claims with the term “adapted to” in the **body** of the claim because the court found “nothing wrong in defining the . . . components . . . in terms of . . . the attributes they must possess”); and *In re Miller*, 441 F.2d 689, 690-94 (CCPA 1971) (overturning the PTO Board of Appeals §112 ¶2 rejection and finding patentable claims with the term “adapted for” in the preamble of the claim)). Applicant’s representative also respectfully notes that, in unpublished decisions available on the PTO’s web site, the Board of Patent Appeals and Interferences on at least two occasions has reversed examiners for rejecting claims containing the term “adapted to” as indefinite under 35 U.S.C. §112 ¶2. (*See Ex parte Beckage* at pp. 4-5 (Bd. Pat. Appl. & Inter. Apr. 25, 2003, Appeal No. 2003-0242 available online at

<http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd030242.pdf>) (reversing the examiner's 35 U.S.C. §112 ¶2 rejection of claims with the phrase "adapted to"; application issued as U.S. Patent No. 6,666,754 on Dec. 23, 2003); and *Ex parte Brick* at pp. 4-6 (Bd. Pat. Appl. & Inter. May 25, 2001, Appeal No. 2001-1794 available online at <http://www1.uspto.gov/web/offices/dcom/bpai/bpai/fd001794.pdf>) (reversing the examiner's 35 U.S.C. §112 ¶2 rejection of claims with the phrase "adapted to"; application issued as U.S. Patent No. 6,308,990 on Oct. 30, 2001).

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. (*See Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991), *cert. denied sub nom.*, *Genetics Inst., Inc. v. Amgen, Inc.*, 112 S. Ct. 169 (1991) (*citing Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985)). The "adapted to" terminology in the claims constitutes functional language which merely defines the claimed components in terms of what they are intended to do. There is nothing intrinsically wrong with the use of this technique in drafting a patent claim. (*See In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971)).

The use of the terminology "adapted to" in claims 41-47 does not render these claims vague and indefinite since one of skill in the art could ascertain the scope of the claims. The examiner has made no showing that one skilled in the art would have any difficulty in determining whether a system for expressing an association between a declaration and an implementation is or is not within the scope of claims 41-47. The examiner has merely cited to the *Hutchinson* case, which for the reasons discussed *supra*, is inapplicable to claims 41-47. Moreover, as also discussed *supra*, courts in more recent cases have found the terminology "adapted to" to be sufficiently definite to comply with the requirements of 35 U.S.C. §112 ¶2.

Because the subject claims 41-47 meet the requirements set forth in 35 U.S.C. §112 ¶2, this rejection should be withdrawn.

IX. Rejection of Claims 1, 12, 16, 24, 28, 34-35, 40-41, and 44-48 Under 35 U.S.C §112, Second Paragraph

Claims 1, 12, 16, 24, 28, 34-35, 40-41, and 44-48 stand rejected under 35 U.S.C. §112, second paragraph "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps." (Office Action at p. 10). Applicant's representative respectfully

submits that this rejection should be withdrawn for at least the following reasons. The claims comply with all the requirements of 35 U.S.C. §112 ¶2. The subject claims do not omit any essential steps and there are no gaps *between* steps as examiner has contended as the basis for this rejection. One of skill in the art could determine the scope of the subject claims, and, hence, withdrawal of the rejection is respectfully requested.

Section 112, paragraph 2, of the Patent Act requires that:

[[t]]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. (35 U.S.C. §112, ¶ 2).

The Federal Circuit has held that “the test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” (*Miles Labs, Inc. v. Shandon*, 997 F.2d 870, 875, (Fed. Cir. 1993) citing to *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Moreover, “[i]f the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.” (*Miles Labs.*, 997 F.2d at 875 citing to *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); *See also Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001); *North American Vaccine, Inc. v. American Cyanamid Co.*, F.3d 1571, 1579 (Fed. Cir. 1993))

The examiner rejects the subject claims under 35 U.S.C. §112 ¶2 contending that the claims lack an essential step and that such omission amounts to “a gap *between* the steps.” (Office Action at p 10) (emphasis added). Applicant’s representative respectfully submits that the claims do not require these additional steps to satisfy the requirements of 35 U.S.C. §112 ¶2 and that no gap *between* the steps exists. Moreover, the examiner has merely proposed steps to be added to the claims without any explanation as to where in the claims the proposed steps should be inserted into the purported gaps *between* the steps, and without any explanation as to why examiner believes such purported gaps exist. Applicant’s representative respectfully submits that examiner’s contentions are insufficient to sustain a rejection under §112 ¶2. To

sustain a rejection under §112 ¶2 requires a showing that one of skill in the art would not be able to determine the scope of the claims as written.

The Office Action rejects claims 1, 12, 28, and 41 contending that these claims “do not recite the specific steps of interpreting or compiling the expressed association in order to provide the association to the target runtime and the steps of providing the association to the target runtime.” (Office Action at p. 10). The Examiner rejects claims 16 and 24 contending that these claims do “not recite the steps of associating a declaration and an implementation before interpreting this association.” (Office Action at p. 10). As to claim 24, the Examiner makes the additional assertion that this claim “does not recite the specific steps of interpreting the association in order to provide the association to the target runtime.” (Office Action at pp. 10-11). Claims 34 and 44 stand rejected under the contention that these claims “do not recite the specific steps of expressing an association and interpreting or compiling the expressed association in order to provide the association to the target runtime and the steps of providing the association to the target runtime.” (Office Action at p. 11). The examiner rejects claim 35 asserting that this claim:

does not recite the steps of interpreting the association according to a default association rule. The claim does not recite the steps of associating a declaration and an implementation before interpreting the association. Also, it does not recite the specific steps of interpreting the association in order to provide the association to the target runtime and the steps of providing the association to the target runtime. (Office Action at p. 11).

The examiner rejects claims 40 and 46-48 contending that these claims:

do not recite the steps of associating a declaration and an implementation before interpreting the association. Also, it does not recite the specific steps of interpreting the association in order to provide the association to the target runtime and the steps of providing the association to the target runtime. (Office Action at p. 11).

The examiner rejects claim 45 contending that the claim:

does not recite the steps of determining whether the associating comprises an override association. The claim does not recite the steps of associating a declaration and an implementation before interpreting the association. Also, it does not recite the specific steps of interpreting the association in order to provide the association to the target runtime and the steps of providing the association to the target runtime. (Office Action at pp. 11-12).

First, as detailed in the specification, the additional steps the examiner proposes would not be performed *between* any of the steps recited in the claims. Therefore, omitting these steps could not amount to a “gap *between* the steps” as the examiner has contended is the basis for the rejection. (Office Action at p 10) (emphasis added). Thus, the basis for rejecting the claims, *i.e.*, that there is a purported gap *between* the steps, is inaccurate. Second, these proposed steps are not necessary for the claims to be definite under 35 U.S.C. §112 ¶2. All that is required under 35 U.S.C. §112 ¶2 is that the claims reasonably apprise those skilled in the art of the scope of the claims. The examiner has made no showing that one skilled in the art would have any difficulty in determining whether a method, system, or computer-readable medium is or is not within the scope of the subject claims. The examiner has merely claimed a purported gap exists *between* the recited steps without explaining where in the claims these gaps purportedly exist and without explaining why such a purported gap exists. Indeed, no gap exists *between* any of the steps recited in the subject claims and one of skill in the art would not have any difficulty determining the scope of the subject claims. Applicant’s representative respectfully submits that the contentions in the Office Action are inadequate to sustain a rejection under 35 U.S.C. §112 ¶2 and that the rejection should be withdrawn.

X. Rejection of Claim 47 Under 35 U.S.C. §101

Claim 47 stands rejected under 35 U.S.C. §101. (See Office Action at p. 12).
Withdrawal of this rejection is requested in view of the amendments to this claim.

XI. Rejection of Claims 1-4, 7, 12-31 and 34-48 Under 35 U.S.C. §102(e)

Claims 1-4, 7, 12-31 and 34-48 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 6,651,248 (“Alpern”). (See Office Action at pp. 12-13). Applicant’s

representative respectfully submits that this rejection should be withdrawn for at least the following reasons. Alpern does not disclose *each and every* limitation of the subject claims. In particular, Alpern does not disclose methods, systems, computer-readable media, and source compilers that employ an ***override association rule*** that allows an association between a declaration and an implementation to be expressed or interpreted *in a language neutral fashion*.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Every independent claim of the subject application (claims 1, 12, 16, 24, 28, 34, 35, 40, 41, 44-48) contains the limitation ***override association rule***. (See Application at pp. 24-34). As described in the specification, the ***override association rule*** serves to provide a runtime with an override association expression where the runtime default association rule may not otherwise be able to determine the proper association. (See e.g., Application at p.4, lines 1-3; p.4, lines 14-16; p. 5, lines 2-9; p. 10, lines 1-5; p. 12, lines 27-30; p. 13, lines 17-30; p. 14, lines 1-5; p. 14, lines 11-14; p. 15, lines 1-4; p. 15, lines 21-27; p. 16, lines 18-20; p. 19, lines 1-5). For example, the ***override association rule*** may be used to express or interpret an association between a declaration and an implementation when the source language association rule is different from a default association rule for the runtime. (See e.g., Application at p. 8, lines 9-11; p. 10, lines 1-5; p. 11, lines 22-28; p.12, lines 4-10; p.12, lines 22-24; p. 14, lines 2-5; p. 14, lines 25-30; p.15, lines 1-4; p. 16, lines 18-21). Thus, the ***override association rule*** allows an association to be expressed or interpreted *in a language neutral fashion*. (See e.g., Application at p. 8. lines 3-5; p. 10, lines 13-15; p. 12, lines 3-4; p.14, lines 2-5; p. 16, lines 4-6, p. 16, lines 26-29).

Alpern does not disclose systems or methods employing ***override association rules***. The examiner cites to col. 8 lines 13-30 of Alpern as disclosing the claim limitation “expressing an association between the declaration and an implementation according to an ***override association rule*** for the target runtime if the source language association rule is different from the default association rule for the target runtime.” (Office Action at p. 14, 16, and 21). The examiner characterizes this section of Alpern as disclosing “[t]he conflict resolution routine pointed to by a given IMT array entry is used to identify . . .the location of the particular interface method . . .

for each virtual method.” (Office Action at p. 14, 16, and 21). The conflict resolution routine cited to by the examiner amounts to no more than a default association rule for the runtime (*i.e.*, an association between an ID value assigned to a signature and a virtual method table (VMT) offset value). (*See* Alpern at col. 8, lines 20-41). Alpern does not teach or suggest an ***override association rule***, which may used, for example, to express or interpret an association between a declaration and an implementation when the source language association rule is ***different*** from a default association rule for the runtime

In view of the foregoing, it is readily apparent that Alpern does not disclose each and every element of the subject claims and therefore does not anticipate the subject claims. It is respectfully requested that the rejection of claims 1-4, 7, 12-31, and 34-48 be withdrawn.

Conclusion

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731